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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/29/2001

Yoshito Katagiri

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06/15/2006

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EXAMINER

REAGAN, JAMES A

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/995,727

Applicant(s)

KATAGIRI, YOSHITO

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 7-9, 11-15, 17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9, 11-15, and 17, 19, and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the Interview conducted on 16 May 2006.
2. The finality of the previous Office action is hereby withdrawn.
3. Claims 1-3, 7-9, 11-15, and 17, 19, and 20 are currently pending and have been examined.

### **RESPONSE TO ARGUMENTS**

4. Applicant's arguments received on 10 January 2006 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

Applicant states, "No prima facie case of obviousness exists with respect to claims 1-3, 7-9, 11-15, 17, 19, and 20 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For example, amended claim 1 recites an electronic appliance comprising, among other things:

a re-writable memory section for recording information regarding a patent relating to a technology adopted in the electronic appliance . . .

a control section to . . . select the appropriate current data to be output in accordance with a sales condition recorded in the re-writable memory section."

The Examiner flatly disagrees. Applicant is merely claiming a computer i.e. an appliance, with an input, output, memory, and processor. Stefik discloses a system of digital rights management, inherently and explicitly disclosing a network of computer systems, each containing an input section, and output section, a rewritable memory section, and a control section. Remaining elements of independent claims 1, 14, and 19 appear to contain non-functional data i.e. data contained within a memory. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Applicant apparently argues that a *prima facie* case of obviousness has not been established. In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has successfully been satisfied, since evidence of corresponding claim elements in the prior art has been presented, and since the Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinctions between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentably invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Simply stated, what distinctions there are, if any, between Applicant's recited system are only found in the non-functional data contained within the memory of the claimed

system, and the corresponding elements of the prior art references is simply not shown to any answerable degree. Also, arguments or conclusions from the Attorney cannot take the place of evidence. In *re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In *re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

With regard to the limitations of claims 1-3, 7-9, 11-15, 17, 19, and 20, Applicant argues that the Examiner has failed to specifically point out how the references disclose or teach each element and limitation recited in the claims. It should be noted that the Examiner is not required to map each limitation to a cited passage within the prior art of reference, as is suggested by the Applicant, nor is it the Examiner's responsibility to translate the technology, techniques, and/or methods of the prior art of record, since it is the assumption of the Examiner that the Applicant and the Applicant's representatives are those of at least ordinary skill in the art. Since the Examiner assumes that the Patents used in making the rejections with regard to and in light of the instant claims have complied with the enablement standards set for the by the United States Patent and Trademark Office, the Examiner correctly deduces that one of common skill would be able to read, understand, and manufacture the innovation as disclosed by the inventors. Subsequently, since the Applicants and their representatives are considered to be at least fundamentally schooled in the arts of the instant invention, it is also correct for the Examiner to infer that the same are capable of comprehending and appreciating the prior art as disclosed by the inventors and accredited by the USPTO. Ergo, the passages cited by the Examiner are a courtesy meant not only to lay a foundation of rejection of the claim limitations, but also to introduce the prior art of record as a benchmark of knowledge currently employed by artisans of the past and present, and also for establishing a pathway for continued prosecution. It is incumbent upon the Applicant and the Applicant's representative, then, to evaluate the prior art of record, point out misconceptions or other inaccuracies made by the Examiner, assert limitations that have not been properly addressed or that are novel, and, if deemed necessary, amend the claims to overcome the prior art of record, each and all in pursuit of an allowance.

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 7-9, 11-15, 17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al., (US 5,715,403 A) in view of Kossovsky et al. (US 2002/0002524 A1).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1-3, 7-9, 11-15, 17, 19, and 20:**

Stefik discloses, "A system for controlling use and distribution of digital works. The present invention allows the owner of a digital work to attach usage rights to their work. The usage rights define how the individual digital work may be used and distributed. Instances of usage rights are defined using a flexible and extensible usage rights grammar. Conceptually, a

right in the usage rights grammar is a label associated with a predetermined behavior and conditions to exercising the right. The behavior of a usage right is embodied in a predetermined set of usage transactions steps. The usage transaction steps further check all conditions which must be satisfied before the right may be exercised. These usage transaction steps define a protocol for requesting the exercise of a right and the carrying out of a right" (see at least the abstract and other relevant text). Stefik, by disclosing a computer and computer network clearly discloses the input, output, display, printing, control, memory, re-writable memory and communication functions as claimed by the Applicant. As such, any computer in use at the time of the invention employing rudimentary software available at the time of conception would be capable of completing the tasks as described in the claim limitations. In addition, Stefik discloses updating digital rights information, expiration of digital rights, renewing of digital rights, and user authentication.

Although Stefik does disclose copy rights i.e. intellectual property rights, Stefik does not specifically state that those rights extend to patent rights. Kossovsky, however, in at least the abstract, paragraph 0005 and 0009 discloses a relationship between intellectual property and patent rights, as well as the sale of IP and associated patent rights. It would have been obvious to one of ordinary skill in the art at the time of the invention to include patent rights as shown by Kossovsky with Stefik's copy rights protection system because it may be, "...used in determining the amount of patent validity insurance provided in the sale of an IP asset (Kossovsky: paragraph 0011)."

In addition, independent claims 1, 14, and 19 appear to contain non-functional data i.e. data contained within a memory. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on 8:00a - 5:00p M-F. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**703.305.7687** [Official communications, After Final communications labeled "Box AF"]

**703.308.1396** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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JAR

Primary Examiner

Art Unit 3621

17 May 2006



**JAMES A. REAGAN**  
**PRIMARY EXAMINER**